IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Steven E. Barile	Examiner: Ryan J. Jakovac
Serial No.:	10/600,179	Group Art Unit: 2445
Filed:	June 20, 2003	Docket No.: P15785
		Confirmation No: 9758

Title: *Method And Apparatus For Caching Multimedia Content From The Internet On Occasionally-Connected Devices*

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

In accordance with the "New Pre-Appeal Brief Conference" notice in the United States Patent and Trademark Office (USPTO) OG Notices dated 2005-07-12, the principal for the present application ("applicant") respectfully requests that a panel of examiners formally review the legal and factual basis of the rejections in the Final Office Action dated October 26, 2011 (the "Office Action"). In accordance with the answers at www.uspto.gov/faq/pre_appealbrief_conf_pilot.jsp, this request is single spaced.

The claims at issue are claims 1, 3-4, 6-17, 19-20, and 22-27, of which claims 1, 8, 12, 17, and 24 are independent. The Office Action rejects claims 1, 3-4, 7-9, 11-15, 17, 19-20, 23-25, 27 under 35 USC § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0052933 to Gerd Leonhard et al. (Leonhard) in view of U.S. Patent No. 7,496,947 to Stephen Meyers (Meyers) and U.S. Patent No. 7,509,421 to Martin R. Lambert (Lambert). In addition, the Office Action rejects Claims 6, 10, 16, 22, 26 under section 103(a) as being unpatentable over Leonhard in view of Meyers, Lambert, and U.S. Patent No. 7,130,251 to Akihiro Morohashi (Morohashi). For at least the reasons set forth below, at least some of those rejections are (a) based on at least one erroneous legal conclusion, (b) based on at least one erroneous factual conclusion, and/or (c) lacking at least one essential element needed for a prima facie case of obviousness.

Independent Claims 1, 12, and 17

According to the method recited in claim 1 of the present application, a portable device occasionally connects to a network and submits a play list to a multimedia content provider through the network. Multimedia content for the play list is downloaded to the portable device, and the portable device is disconnected from the network. The multimedia content is played on the portable device. Also, feedback from the user about the multimedia content is recorded on the portable device. When the portable device connects to the network the feedback is uploaded to the multimedia content provider, and the multimedia content provider uses the ratings to provide recommended multimedia content to the user. In addition, regarding the playlist, the

method involves creating an initial play list, expanding the initial play list by recommending to the user additional content unrelated to preferences of the user, and refining the expanded initial play list based on the feedback from the user. Also, claim 1 recites that the multimedia content comprises at least one first title protected by a first digital right management (DRM) system and at least one second title protected by a different DRM system.

Claim 1 also recites that he operation of playing the multimedia content comprises:
- accessing the multimedia content; and
- rendering the multimedia content to the user.

In addition, claim 1 recites that the operation of accessing the multimedia content comprises
- using the first DRM system to access the first title and using the different DRM system to access the second title.

In other words, the operations of "using the first DRM system to access the first title and using the different DRM system to access the second title" are part of the operation of "playing the multimedia content on the portable device." Thus, according to claim 1, the operations of "using the first DRM system to access the first title and using the different DRM system to access the second title" are both performed on the portable device. In other words, the portable device plays two (or more) different titles using two (or more) different DRM systems.

Furthermore, to clarify what is meant by a "DRM system," claim 1 recites that "at least the first DRM system enforces protection policies that prevent the first title from being copied from the portable device and played by another user and that prevent the portable device from playing the first title after expiration of a predetermined period of time."

The rejection of claim 1 in the Office Action is based either on (a) the erroneous legal conclusion that the claims do not require the portable device to play different titles using different DRM systems or (b) the erroneous factual conclusion that Lambert discloses a portable device that plays different titles using different DRM systems.

Lambert pertains to a "distributed DRM system" involving both a "DRM server" and a "DRM client" (col. 11, lines 27:39). This distributed system is supposed to overcome some of the problems with conventional DRM systems that rely exclusively on either "server-side rights management" or "client side rights management" (col. 2, line 52, through col. 4, line 59). Accordingly, even if Lambert were to be interpreted as teaching the use of two different DRM systems, consisting of "server-side rights management" and "client side rights management," that interpretation would not cover claim 1. Claim 1 does not recite the general idea of using two different DRM systems, without regard to whether those DRM systems operate on a client or a server. Instead, claim 1 specifically dictates that both DRM systems operate on the portable device.

The Office Action cites to the following portions of Lambert as allegedly teaching the operation of using a first DRM system to access a first title: col. 5, lines 35-67; and col. 11, lines 27:39. Applicant does not dispute that lines 35-67 of col. 5, can be interpreted as teaching a DRM system that operates on the client. For instance, lines 44-45 refer to "a DRM client on a consumer content rendering device." Also, as indicated above, lines 27-39 of col. 11 explain that the DRM client cooperates with the DRM server, according to Lambert's "distributed DRM system."

However, with regard to the second or "different" DRM system that is also supposed to operate on the portable device according to claim 1, the Office Action cites to col. 6, lines 35-45, of Lambert. That portion of Lambert, however, does not disclose a second or different DRM system operating on the client. Instead, that portion of Lambert explains how the (single) DRM

system on the client (the "DRM client") cooperates with the DRM system on the server (the "DRM server"). Specifically, in lines 6-10 of col. 6, Lambert explains that "[t]he DRM server may be arranged so that the <u>first rights management decision</u> includes the DRM server refusing to grant a said DRM client the right to access the content on the basis that granting the right would cause a concurrent consumer limit to be exceeded" (emphasis added). Then, lines 35-67 of col. 6 explain that the DRM client is "arranged to make a <u>second rights management decision</u> based on a said result received from a said DRM server," where this "second rights management decision includes determining whether the DRM client has a right to print the content [and/or] a right to save the content to a storage device" (emphasis added).

Unfortunately, the Office Action is not clear about precisely which of the features in col. 6, lines 35-45, allegedly constitute a second DRM system operating on the portable device. In other words, the Office Action fails to establish a prima facie case of obviousness, because it lacks support for the assertion that Lambert discloses more than one DRM system operating on the portable device.

In addition, the Office Action might be attempting to assert that the "DRM server" constitutes a second DRM system operating on the portable device. That assertion would be factual incorrect, however, as the DRM server of Lambert clearly does not constitute a DRM system operating on the client.

Alternatively, the Office Action might be attempting to assert that the operation of making a "second rights management decision" at the client (based on the "first rights management decision" from the DRM server) somehow teaches a second DRM system operating on the portable device. That assertion would also be factual incorrect. Lambert teaches that the DRM client makes a decision based on a prior decision made by the DRM server, and Lambert refers to that decision of the DRM client as a "second rights management decision." However, simply referring to a decision made by the DRM client as a "second" decision does not constitute disclosure of a second (or "different") DRM system operating on the client.

The Office Action also refers to col. 4, lines 4-8, of Lambert. Those lines explain that "the client-side rights management can often also enforce various access policies such as locking the content to a specific consumer device ('node-locking'), expiring access to the content after a certain time, etc." However, this teaching doesn't seem to add anything significant, with regard to the required elements of a prima facie case of obviousness for claim 1 pertaining to more than one DRM system operating on the portable device.

For at least the foregoing reasons, the conclusion in the Office Action -- that Lambert teaches more than one DRM system operating on the portable device -- is factually incorrect. Therefore the rejection of claim 1 lacks at least one essential element needed for a prima facie case of obviousness.

In addition, the independent claims 12 and 17 also involve features like those discussed above with regard to claim 1, and the Office Action rejects those claims on the same bases as claim 1. Therefore, the Office Action fails to establish a prima facie case of obviousness for claims 12 and 17.

Also, the dependent claims implicitly include all of the features of their respective parent claims, but the rejections of those claims do not overcome the shortcomings described above with regard to independent claims 1, 12, and 17. For at least the foregoing reasons, the Office Action fails to establish a prima facie case of obviousness for claims 3-4, 6-7, 13-16, 19-20, and 22-23.

Independent Claims 8 and 24

Similarly, Claim 8 involves "transferring the multimedia content to the portable device, wherein the multimedia content comprises at least one first title protected by a first digital right management (DRM) system and at least one second title protected by a different DRM system." And claim 24 involves similar features. The Office Action asserts that those features are shown in the same portions of Lambert referenced above. However, as indicated above, those portions do not teach the use of more than one DRM system on the portable device.

For at least the foregoing reasons, the conclusion in the Office Action -- that Lambert teaches transferring titles protected by multiple different DRM systems to a portable device -- is factually incorrect. Therefore the rejections of claims 8 and 24 lack at least one essential element needed for a prima facie case of obviousness.

Also, the dependent claims implicitly include all of the features of their respective parent claims, but the rejections of those claims do not overcome the shortcomings described above with regard to independent claims 8 and 24. For at least the foregoing reasons, the Office Action fails to establish a prima facie case of obviousness for claims 9-11 and 25-27.

Dependent Claims 6, 16, and 22

In addition, claim 6 depends from claim 1 and recites that "the operation of accessing the multimedia content comprises at least one of the following: unpacking, decrypting, decompressing, and decoding the multimedia content. And since claim 1 recites that "the operation of accessing the multimedia content comprises using the first DRM system to access the first title and using the different DRM system to access the second title," claim 6 requires that the first DRM system and the second (or "different") DRM system are used by the portable device to unpack, decrypt, decompress, and/or decode the first and second titles. However, the rejection of claim 6 does not overcoming the shortcomings described above with regard to claim 1. In particular, the Office Action cites to col. 11, lines 13-34 of Morohashi with regard to claim 6, but that portion of Morohashi does not disclose or suggest a portable device that uses different DRM systems to unpack, decrypt, decompress, and/or decode the different titles. For at least the foregoing reasons, the Office Action fails to establish a prima facie case of obviousness for claim 6.

In addition, claims 16 and 22 involve similar features to those discussed above with regard to claim 6, and those claims are rejected on the same basis as claim 6. For at least the foregoing reasons, the Office Action also fails to establish a prima facie case of obviousness for claims 16 and 22.

Conclusion

This request is being filed with PTO Form SB/33 and with a Notice of Appeal and the corresponding fee. No additional fees are believed to be due for this request. Nevertheless, the Commissioner is authorized to use Deposit Account 50-4238 to charge any fees necessary for the filing of this request, including extension of time fees, or to credit any overpayment.

Respectfully submitted,

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